

## **REMARKS**

Favorable reconsideration of this application, in view of the foregoing amendments and following Remarks, is respectfully requested.

Referring to the Sections as set forth in the "Detailed Action" section of the first Official Action mailed 10/24/2005:

### **Claim Objections**

Claim 4 has been amended to delete the word "diameter" and substitute the correct word "durometer", as required by the Examiner to overcome the objection to this informality in claim 4.

### **Claim Rejections – 35 U.S.C. §102**

The Examiner has rejected claims 1, 2, 3 and 6 under 35 U.S.C. §102(b) as allegedly being anticipated by the Igarashi et al. U.S. Patent 4,870,995. With respect to applicant's claim 1 as filed, the Examiner erroneously alleges that Igarashi et al. teaches a number of limitations of claim 1 that are not found in Igarashi et al. to wit:

- (1) First of all, the Examiner alleges that Igarashi et al. teaches a "method". Despite a careful review of the '995 patent, the undersigned cannot find any text in the '995 patent stating that this patent discloses any method (or process). All the claims 1-6 in this patent are directed to a hose construction as an article of manufacture. The same is true of the description in the "Abstract" of the '995 patent. The "Summary of the Invention" in column 2 of the '995 patent further makes it clear that the patent is directed to a hose incorporating structural features set forth in the "Background of the Invention" section, and more particularly to an

automobile power steering hose which excels in heat resistance. Therefore, the Examiner's assertion that the '995 patent teaches a "method" is clearly in error.

(2) With respect to claim 1, the Examiner further asserts that the '995 patent teaches "a method of dampening fluid-borne noise in an automotive power steering system..." (Underscoring added). Again, this is clearly an erroneous assertion inasmuch as there is absolutely nothing in the '995 patent about "noise" per se, much less "dampening fluid-borne noise" in an automotive power steering system. The '995 patent is completely devoid of any disclosure either implicit or explicit regarding the effect of the hose construction disclosed in the '995 patent on fluid-borne noise in a power steering system. Instead the entire thrust of the '995 patent is to improve heat resistance of the power steering hose. Accordingly, this ground of rejection of claim 1 is also in error.

(3) The Examiner also asserts, with respect to claim 1, that the '995 patent discloses a hose construction with "the inner layer being softer than the outer layer". Again, there is absolutely nothing in the '995 patent stating or implying that the inner layer 31a is softer than the outer layer 31b. Therefore, this further assertion by the Examiner is also in error.

(4) The Examiner further asserts, with respect to claim 1, that the '995 patent discloses a hose wherein the radial thicknesses  $T_1$  and  $T_2$  have a ratio "selected to dampen fluid-borne noise...". There is nothing in the '995 patent so stating, nor is it to be found in the various Tables set forth in columns 8-15 of the '995 patent. Nowhere is the effect on fluid-borne noise set forth as a parameter in these testing results or elsewhere in the description of the '995 patent.

(5) The Examiner additionally asserts that the '995 patent teaches "the radial thicknesses  $T_1$  and  $T_2$  having a ratio selected to dampen fluid-borne noise within a preselected frequency range...". Clearly there is no disclosure of any frequency range of noise dampening, much less a preselected frequency range, anywhere in the '995 patent.

Accordingly in view of items (1) – (5) above, the Examiner's stated grounds in support of the rejection of claim 1 as being anticipated under 35 U.S.C. §102(b) by Igarashi et al. U.S. 4,870,995 is manifestly in error for at least the foregoing reasons.

The Examiner rejects dependent claims 2 and 3 under §102(b) over the '995 patent on the basis of inherency, asserting that the Igarashi et al inherently teaches that the thickness ratio is in the range of 30:70 to 70:30 as recited in claim 2. The Examiner thus agrees that there is nothing expressly taught in the '995 patent of these specific limits of the range of selected ratios. Instead the thickness ratios are only set forth in Tables 8, 9, 10, 11 and 12 of the '995 patent. Tables 8, 10, 11 and 12 set forth a ratio of 50:50, and Table 9 sets forth a range of values; i.e., specifically 6% ("0.06"), 12% ("0.12"), 50% ("0.50"), 88% ("0.88") and 94% ("0.94"). Thus, none of these '995 ratios expressly anticipate the recited ratio range of "30:70 to 70:30" set forth in claim 2. Nor is there any basis for an inherency teaching of "30:70 to 70:30" as recited in claim 2. Hence, the assertion of the Examiner to the contrary is clearly in error.

Claim 3 has been cancelled and hence the rejection of claim 3 is now moot.

The Examiner also asserts anticipation by the '995 patent with respect to dependent claim 6 (initially dependent on originally filed claim 1 and now dependent on the revision thereof set forth as new claim 8). The Examiner states that the '995 patent teaches "wherein the inner tube is of ethylene/acrylic elastomeric container (sic, material). In support of this assertion, the Examiner cites essentially all of the material appearing in the '995 patent in columns 3 and 4 of the description without specifying the particular text lines within this broad range of text that specifically teach this limitation. The Examiner also states that the container tube (outer layer of said inner tube) is of "peroxide-vulcanized acrylonitrile butadiene copolymer, again without citing the specific line or lines within this broad range of text material in '995 patent that allegedly so states. The Examiner thus leaves to guess work the finding of such alleged support. This ground of rejection therefore is in error and in violation of MPEP 2131. Hence, unless and until the Examiner can specifically cite support in the aforementioned two entire columns of '995 for a teaching of the aforementioned limitations, the same should be withdrawn.

In summary, it is respectfully submitted that the foregoing rejections under 35 U.S.C. §102 are in error in both fact and law for the reasons set forth above as well as those set forth hereinafter.

### **Applicable Law - Anticipation**

It is axiomatic that, in order to "anticipate" a claim, "all the elements in the claim (or possibly their equivalents...) must have been disclosed in a single prior art reference or device." *Radio Steel & Mfg. Co. v. MTD Products, Inc.*, 731 F.2d 840, 845, 221 U.S.P.Q. 657, 661 (Fed. Cir. 1984). Moreover, "it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1462 (BPAI 1990). It is respectfully submitted that the cited reference '995 patent fails to disclose or suggest all of the elements of independent parent claim 1 as filed or amended. Nor has the Examiner properly identified where, in the cited '995 patent, it allegedly teaches "each and every facet" of the invention as claimed.

As further set forth in M.P.E.P. § 2131 (pgs. 2100-54 and 2100-55):

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1990).

As further pointed out in M.P.E.P. § 706.02 (pgs. 700-10).

"The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection

based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made."

It is further noted that the Examiner has attempted to predicate the § 102 rejection of claims 2 and 3 solely on the basis of "inherency", and hence "inherency" is also an issue as to this rejection. The applicable law regarding inherency and illustrating the Examiner's error in this regard may be summarized by the fundamental question "what has the prior art has disclosed? The fact that a prior art device "may" perform the claimed process or the prior art process "may" produce the claimed device is insufficient to show anticipation; the prior art must show the specific claimed features, either expressly or inherently.

In this regard, the CCPA has added that "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *In re Oelrich*, 666 F.2d 578, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 687 (C.C.P.A. 1939)(emphasis in original). That is, the missing element or function must necessarily result from the prior art reference.

"Occasional results are not inherent." *Mehl/Biophile Int'l Corp v Milgraum*, 192 F.8d 1362, 52 USPQ2d 1303, 1306 (Fed. Cir. 1999).

As Judge Learned Hand stated in Dewey:

"No doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bear within its four corners adequate directions for the practice of the patent invalidated. If the earlier disclosure offers no more than a starting point for further experiments, if its teaching will sometimes succeed and sometimes fail, if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common

knowledge, and it is not an anticipation. *Dewey & Almy Chem. Co. v Mimex Co.*, 124 F.2d 986, 989 (2d Cir. 1942).

As set forth previously herein, when an Examiner's rejection relies on inherency, it is incumbent on the Examiner to point to the page and line of the prior art that justifies the rejection. For example, in *Ex parte Schricker*, 56 USPQ2d 1728 (B.P.A.I. 2000)(unpublished), the invention was a method of treating fish with a substance, porcine somatotropin, to increase protein content and protein accretion or to decrease fat content and fat accretion. The Examiner rejected the claims based on inherency.

The Examiner asserted that, the "[prior art] system has not been demonstrated to be different than that claimed. That is, the claimed 'increasing the protein content and fat accretion of fish' would be inherent in the use of the porcine somatotropin of [the prior art].

On appeal, the Board reversed, stating:

[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory...The examiner has left applicant and the board to guess at the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which [prior art] document supports the rejection. We are not good at guessing; hence, we decline to guess.

### **Prior Art Rejection – Background**

It is respectfully submitted that it may be helpful to review the problems to which the invention is directed, namely, noise generated by the power steering pump and/or steering gear in a power steering system for use for present day automobile power steering systems that use power steering hoses. As pointed out on page 1 of applicant's description the prior art is replete with a relatively long history of disclosures that describe devices incorporated inside the power steering hose or connected in line with the power steering hoses to dampen this noise.

However, as to improvements in the construction of the power steering hose itself, the emphasis has been in the direction of developing improved heat resistance, which in turn should result in longer service life in the adverse automotive engine compartment environment. To achieve this, higher temperature materials, such as chlorosulfonated polyethylene and hydrogenated nitrile have been used. Indeed, the sole prior art reference relied upon by the Examiner in his §102 and §103 rejections, namely the Igarashi et al. U.S. Patent 4,870,995, is a teaching primarily of this nature, namely, a power steering hose construction directed to enhanced heat resistance to thereby increase service life, and hence suitable for use in automobile power steering units. However, as set forth above, the '995 patent does not discuss or suggest noise characteristics of the hose construction disclosed therein, nor selection of a thickness ratio for achieving desired noise damping properties.

In accordance with the present invention, the method of dampening fluid-borne noise in an automotive power steering system, as recited in claims 2 and 4-9, deviates from the current thinking in power steering pressure hoses by using a material for the inner tube that would have good noise dampening properties, such as an ethylene/acrylic elastomer, without sacrificing resistance to high temperature fluid being conducted through the hose. This inner tube 14 is bonded through vulcanization to an outer tube 16 that is made of a material that possesses less noise dampening characteristics. By adjusting the thickness of the inner tube 14 (high noise dampening properties) in relation to the outer tube 16 (low noise dampening properties), the noise dampening ability of the hose can be varied to maximize noise dampening in a selected frequency range as found by empirical determination.

Thus, although high expansion pressure hose constructions have been in production for a number of years, as has the ability and knowledge to co-extrude two different materials at the



same time, so far as is known, there is no power steering hose construction that employs a method of dampening fluid-borne noise by using materials possessing different degrees of noise dampening properties to help create the amount of noise dampening desired and still maintain the high fluid temperature resistance properties for prolonged service life.

### **Discussion of Cited References Relied Upon in the Section 102 and 103 Rejections**

#### **Igarashi et al. 4,870,995**

The '995 patent states in the "Abstract" that:

High performance hose is disclosed which is characterized by enhanced heat resistance, leading to prolonged service life, and hence are suitable for use in automobile power steering units. The inner tube has a double-layered construction composed of an inner layer of hydrogenated acrylonitrile/butadiene copolymer rubber and an outer layer of rubber composition which comprises specified amounts of a selected class of sulfurs, organic peroxide and triazine compounds combined with selected sulfur-curable base rubbers.

As indicated above, it is not seen, nor has the Examiner specifically pointed out, where there is an express teaching in the '995 patent of the specific materials taught by applicant and recited in claim 6 as amended, namely that the inner layer 14 of the inner tube 12 is of "ethylene/acrylic elastomeric material", and that the outer layer 16 of said inner tube 12 is of "peroxide-vulcanized acrylonitrile-butadiene copolymer rubber". Indeed, the latter material in the '995 Abstract appears to be used in the inner layer 31a rather than the outer layer 31b.

In any event, and as indicated above, there is absolutely no disclosure in the '995 patent, whether by express teaching, drawings, or inherency of any type, regarding any method, much less a method of dampening fluid-borne noise in an automotive power steering system. Moreover, there is no disclosure that the inner layer 31a of '995 hose construction is softer than

the outer layer 31b. Indeed, hardness or softness is nowhere disclosed in the '995 patent for any of the layers of the multilayer hose construction.

In addition, there is nothing in the '995 patent about selecting a ratio of  $T_1$  to  $T_2$  that achieves or is intended to dampen fluid-borne noise within a power steering system, much less to dampen noise within a preselected frequency range.

Also, there is nothing in the '995 patent that would provide a range of 30:70 to 70:30 as specified in applicant's claim 2. At best, Table 9 of '995 teaches a ratio range of 06:94 to 94:06 and hence could not inherently anticipate the more specific and narrower ratio range, as claimed by applicant in claim 2, one that is well within both end limits of such a larger thickness ratio range as interpolated from Table 9 of '995.

In view of the foregoing, it is respectfully submitted that the Examiner's assertion that claims 1, 2, 3 and 6 as originally filed are anticipated by the Igarashi et al. U.S. Patent 4,870,995 is clearly in error factually as well as in law.

**Application Claims 1-7 as Filed and Application Claims 2 and 4-9 as Amended or Newly Presented Not Anticipated By Cited Reference**

With the foregoing in mind it will now be apparent that the cited patent reference, Igarashi et al. 4,870,995, does not disclose, teach or otherwise anticipate or suggest a method of using a specific hose construction for dampening fluid-borne noise in automotive power steering system (as set forth in claims 2, 4-6, 8 and 9), nor a method of making a power steering pressure hose having a predetermined fluid-borne noise dampening characteristic (as set forth in claim 7 as amended), contrary to the Examiner's assertion to this effect on pages 2 and 3 of the Action. Not only is the '995 cited reference completely silent on any noise suppression effect of the disclosed hose construction, there is nothing in the '995 patent relative to a method of dampening

fluid-borne noise, nor a method of using a specific (empirically determined) hose construction for making a power steering pressure hose having predetermined fluid-borne noise dampening characteristics. Thus, this cited patent reference, taken as a whole, could not possibly, properly or lawfully "anticipate" any of claims 2, and 4-9 as now presented.

Note that new claim 8, which is a re-write of claim 1, recites in method step (b) selecting by empirical determination a ratio of radial thicknesses  $T_1$  to  $T_2$  found to maximize dampening of fluid-borne noise in said automotive power steering system within a preselected frequency range by elastic radial expansion of the inner and outer layers. Nothing in the cited '995 patent or any of the other prior art cited by the Examiner or applicant anticipates or suggests this novel noise-reducing method step. Method claims 2, 4, 5 and 6 and claim 9 are either directly or successively dependent on independent claim 8 and likewise distinguish patentably for at least the reasons set forth with respect to claim 8.

Claim 7 as amended calls for, in method step (c), selecting by empirical determination a ratio of said radial thicknesses within said range of about 30:70 to 70:30 to maximize dampening of fluid-borne noise by elastic radial expansion of said inner and outer layers. Again, nothing in the prior art, nor specifically in the cited '995 patent, anticipates or suggests this novel noise dampening method step.

#### **Claim Rejections Under 35 U.S.C. §103 – Pages 3 and 4 of the Action**

The Examiner has rejected under 35 U.S.C. §103(a) claims 4, 5 and 7 as originally filed as allegedly being unpatentable over the '995 patent. At the outset, the Examiner admits that the '995 patent does not explicitly disclose wherein the '995 inner layer 31a has a hardness in the range of 70 to 80 durometer. The Examiner also admits that the '995 patent does not teach the limitation "wherein the preselected frequency range is 300 to 400 Hz". These cited

limitations that are missing from '995 are respectively found in applicant's claims 4 and 5 that were each directly dependent on originally claim 1, and now on claim 8. Of course, claims 4 and 5 distinguish patentably under §103 because of the various failures of disclosure of the '995 patent relied upon in the §102 rejections.

Nevertheless the Examiner states that it would have been "an obvious matter of design choice to provide the inner layer with a hardness in the range of 70 to 80 durometer". How could this be "an obvious matter of design choice" when the '995 patent nowhere treats the parameter of hardness and softness in the materials of either of the inner or outer layers 31a and 31b of the '995 power steering hose 30. One can not choose from what is unknown. Only applicant's disclosure teaches a method of noise reduction in the power steering hose utilizing this specific parameter of hardness in the recited inner layer 14 of applicant's hose construction.

The Examiner also states that it would be "an obvious matter of design choice" to provide the method recited by applicant of dampening fluid-borne noise in the preselected frequency range of 300 to 400 Hz "since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or working ranges involve only routine skill in the art". The so stated rationale for this rejection of these two recited novel parameters, as set forth in claims 4 and 5, fails because the "general conditions" for applicant's method claims are not disclosed in the cited '995 patent, contrary to the Examiner's assertion. Hence, the cited case of *In re: Aller* does not apply, or if applied, supports the opposite conclusion from that for which it is relied upon by the Examiner.

Additionally, the Examiner states that it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, citing *In re Boesch*, 617F.2d 272, 205 U.S.P.Q. 215 (CCPA 1980). However, nowhere does the '995 patent

teach or suggest that the thickness ratios of the inner and outer layers in the various '995 patent hose constructions have any effect on fluid-borne noise in a power steering system or hose. Hence, the '995 patent does not teach the result claimed by applicant nor, for that matter, any result as being obtained from an empirically determined  $T_1:T_2$  ratio variable. Much less does '995 teach that a hose laminate thickness ratio is a result effective variable for the result of noise dampening.

**Applicable Law – 35 U.S.C. § 103 (a)**

Before discussing what is respectfully submitted as misapplication of the '995 reference by the Examiner to the application claims, standards for analysis of this reference and application of the same to the invention also bear restating. As the CCA well stated in In re Carroll, 202 U.S.P.Q. 571, 572 (1979):

One of the more difficult aspects of resolving questions of non-obviousness is the necessity "to guard against slipping into use of hindsight." Graham v. John Deere Co., 383 U.S. 1, 36, 148 U.S.P.Q. 459, 474 (1965). Many inventions may seem obvious to everyone after they have been made. However, 35 U.S.C. 103 instructs us to inquire into whether the claimed invention "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

The standard of Section 103 is thus not what could be read into the reference having applicant's disclosure and claims in mind.

It is difficult but necessary that the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time when the invention was made . . . , to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom of the art.

W. L. Gore & Assoc. Inc. v. Garlock, inc., 220 U.S.P.Q. 303, 313 (CCPA 1983). The cited reference patent must be viewed for what it teaches the artisan who has in mind the problem to which applicant's invention is directed, but not applicant's solution to the problem. Unquestionably, such standards for review are often more easily stated than applied, particularly when applicant's solution is seemingly simple and straightforward when viewed with the benefit of hindsight. In re Carroll, supra; In re Spoke, 133 U.S.P.Q. 360, 363 (CCPA 1962); In re Marshall, 198 U.S.P.Q. 344 (CCPA 1978).

As to the aforementioned improper "obvious to try" type rejection as stated in the rejection, the commentary by Judge Ridge in the decision of the Court of Customs and Patent Appeals in the case of *In re Tomlinson, Hall and Geigle*, 363 F. 2d 928 at 931, 150 U.S.P.Q. 623 at 626 (CCPA, 1966) is informative:

We agree with appellants that claims should not be considered in the abstract, particularly when the invention is the result of a selection or screening process. While the ultimate question, of course, is whether the invention defined by the claims is patentable over the art, frequently evidence on background and the circumstances surrounding the making of the invention is helpful in deciding that question. . . .Slight reflection suggests, we think, that there is usually an element of "obviousness to try" in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success, and that patentability determinations based on that as the test

would not only be contrary to statute but result in a marked  
deterioration of the entire patent system as an incentive to invest in  
those efforts and attempts which go by the name of "research".  
(underscoring added)

Accordingly, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103 (a) with respect to any of the remaining claims 1, 2, and 4-9 as amended and/or newly presented by utilizing the '995 reference relied upon in the first Office Action relative to these claims.

To reiterate, it is respectfully submitted that the Examiner's stated rejection is tantamount to the "obvious to try" type rejection that has been clearly and repeatedly ruled improper under 35 U.S.C. § 103 by the Federal Circuit. The standard of 35 U.S.C. § 103 is not that it would be obvious for one of ordinary skill in the art to try to achieve the invention; indeed, disregard for the nonobviousness of the results of the "obvious to try" experiments disregards "invention as a whole" concept of § 103. See in re O'Farrel 7 U.S.P.Q. 2d 1673 (Fed. Cir. 1988); Hybritech Inc v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81 (Fed. Cir. 1986); in re Antonie, 95 U.S.P.Q. 6 (C.P.P.A. 1977).

In view of the foregoing, it is respectfully submitted that the Examiner has failed to articulate the requisite teaching, suggestion or motivation to modify the cited '995 reference with the ordinary skill in the art as required to render the claims at issue obvious under 35 U.S.C. § 103. Indeed, this reference cannot be so modified, based on its disclosure and without using hindsight, to perform the novel methods as set forth in claims discussed hereinabove. Thus, the Examiner has made no particular findings nor set forth the findings regarding the locus of the

suggestion, teaching or motivation for the person of ordinary skill in the art to modify the cited prior art reference to achieve the method of noise-dampening as claimed, as consistently required by the Federal Circuit. Therefore, it is respectfully submitted that the Examiner has failed to present a *prima facie* case of obviousness of applicant's invention as now claimed in claims 2 and 4-9 as amended and/or newly presented.

To establish *prima facie* obviousness of a claim to an invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.P.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.P.P.A. 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988) (MPEP 2143.02).

As set forth in MPEP 2142, if the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. Further, to establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Such is not present in the cited reference patent.

Second, there must be a reasonable expectation of success. Nothing in the cited reference patent would give rise to such an expectation.

Thirdly, the prior art reference must teach or suggest all the claim limitations. Clearly it does not.



The teachings or suggestions to make the claimed combination or modification and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d (Fed. Cir. 1991). The initial burden is on the Examiner to produce some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the reference(s) must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (underscoring added) (MPEP 2142) citing Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). It is respectfully submitted that the present rejection clearly fails to meet the foregoing legal criteria.

#### **Process (or Method) Claims for New Use for Old Product**

It is also submitted, arguendo (and without inference or admission that the recited hose is an "old product or manufacture as claimed), that it is also well recognized that one may obtain a process claim (or method claim) for a novel process (or method) which consists of making a new use of an old manufacture or product, 35 U.S.C. §100(b) and §101; *Dawson Chem. Co. v. Rohn and Haas Co.* 448 U.S. 176, 206 U.S.P.Q. 386, 1980; *Loctite Corp. v. Ultraseal Ltd.*, 781 Fed 2<sup>nd</sup> 861, 875; 228 U.S.P.Q. 90, 99 (Fed Cir. 1985).

See also M.P.E.P. Section 2112.02 on page 2100-60 (Rev. 3, August 2005) under the heading: "Process of Use Claims – New and Unobvious Uses of Old Structures and Compositions May Be Patentable". The M.P.E.P. text at this point states: "The discovery of a new use for an old structure based on unknown properties of the structure might be patentable to

the discoverer as a process of using. Citing *In re Hack*, 245 Fed 2<sup>nd</sup> 246, 248; 114 U.S.P.Q. 161, 163 (CCPA 1957).

As set forth in Donner, Patent Prosecution, Law, Practice and Procedure, 4<sup>th</sup> Ed., Vol. 1, 2005, at pp. 966 and 967:

A holding of no anticipation may be found in instances where the general subject matter is the same, but the specific application or use is different. For example, in *Union Oil Co. of California v. Atlantic Richfield Co.*, the invention related to automotive gasoline compositions that reduced automobile tailpipe emissions. The inventors sought to reduce the levels of carbon monoxide (CO), nitrous oxide (NO<sub>x</sub>), and hydrocarbons (HC) emitted from automobile tailpipes. After considerable experimentation, the inventors discovered relationships between the various petroleum characteristics described above and tailpipe emissions.

Atlantic Richfield originally sued Unocal in district court, seeking a declaratory judgment to invalidate the patent. Unocal counterclaimed, alleging willful infringement of the patent. The district court then construed the claims of the patent and limited the claims to automotive fuels. As an example, dependent claim 117 recited, when placed in independent form:

117. [An unleaded gasoline fuel suitable for combustion in an automotive engine, said fuel having a Reid Vapor pressure no greater than 7.0 psi, and a 50% D-86 distillation point no greater than 200 degrees F., and a 90% D-86 distillation point not greater than 300 degrees F., and a paraffin content greater than 85 volume percent, and an olefin content less than 4 volume percent] wherein the maximum 10% distillation point is 158 degrees F (70 degrees C.).

The district court emphasized that the claims of the patent recited either “[a]n unleaded gasoline suitable for combustion in an automotive engine” or “[a]n unleaded gasoline fuel suitable for combustion in a spark ignition automotive engine.” In addition, the court noted that the specification also focused on automobile engines. On this basis, the court held that the claims were not anticipated by prior art aviation and racing fuel compositions that were alleged to be the same by Atlantic Richfield.

On appeal, the Federal Circuit affirmed. The court reasoned:

Because the '393 patent [U.S. Patent 5,288,393] covered only standard automotive fuel, the district court correctly determined that specialty fuels within other limitations of the claims do not anticipate under 35 U.S.C. Section 102. In other words, the aviation and racing fuels that allegedly invalidate the '393 claims do not anticipate because they do not contain each and every limitation of the claims... Specifically, this alleged prior art does not include the limitation of being a standard automotive fuel composition. Moreover, the record does not show that the aviation and racing fuels otherwise have the claimed characteristics of the particular standard automotive fuels recited in the '393 patent. While the record shows that some properties of the aviation and racing fuels coincide with the properties of the '393 patent's claims, the record does not show the presence of each and every limitation.

Accordingly, the Federal Circuit held that composition claims that cover only standard unleaded automotive gasoline were not anticipated by aviation and racing fuels, since the prior art compositions did not include the limitation of being, or being applicable to, a standard automotive fuel. Therefore, the Federal Circuit held that prior art racing and aviation fuels did not contain each and every limitation of the claims at issue and were therefore not anticipated.

....

Subsequent to the *Ochiai* and *Brouwer* decisions, the Patent Office published additional guidelines in view of those decisions. Guidance on Treatment of Product and Process Claims in Light of *In re Ochiai*, *In re Brouwer*, and 35 U.S.C. 103(b) O.G. 86 (1996). The Office indicated that the decisions relate to process claims directed to making or using nonobvious products. It characterized the holdings of *Ochiai* and *Brouwer* as follows: "[T]he Court held that there simply was no suggestion or motivation in the prior art to make or use the nonobvious products to which the claims were limited and consequently overturned the rejections based upon 103.

Relying on this interpretation of the *Ochiai* and *Brouwer* decisions, the Patent Office directed Examiners to examine process claims as follows:

Interpreting a claimed invention as a whole requires consideration of all claim limitations. Thus, language in a process claim which recites making or using a nonobvious product must be treated as a material limitation, and a motivation to make or use the nonobvious product must be present in the prior art for a 103 rejection to be sustained.

In light of *Ochiai* and *Brouwer*, Office personnel will consider all claim limitations when analyzing process claims which make or use nonobvious products under 103.

#### **Conclusion – Action Page 4**

The prior art made of record and not relied upon, but found by the Examiner to be considered pertinent to applicant's disclosure, has been reviewed. It is respectfully submitted that such additional references are either not pertinent or, at best, merely cumulative to the disclosures of the cited Igarashi et al. '995 reference patent relied upon by the Examiner in his rejection. As is true of the '995 primary and sole reference relied upon by the Examiner, none of the prior art made of record and not relied upon, but stated by the Examiner to be considered pertinent to applicant's disclosure, discloses or suggests, either expressly or by inherency, anything to do with a noise parameter either in terms of a method for affecting such a parameter or a hose construction made and used for doing the same.

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In short, none of the claims 1-7 as filed, and clearly none of the claims 2 and 4-9 as herewith amended and/or newly presented, are in any way "anticipated" by any one of the cited reference patents under 35 U.S.C. §102(b), nor rendered obvious under 35 U.S.C. §103 over any one or more of these patent references. Accordingly, in view of the foregoing

amendments and Remarks, this application now appears to be in condition for allowance with claims 2 and 4-9 as amended and/or newly presented, and such action is respectfully solicited.

If it is determined that any fees are due with this submission, the Commissioner is hereby authorized and respectfully requested to charge such fee to our deposit account No. 50-0852.

Respectfully submitted,

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